<u>REMARKS</u>

The present application was filed on August 7, 2000 with claims 1-15. Claims 1-15 remain pending. Claims 1, 8 and 15 are the pending independent claims.

In the outstanding final Office Action dated January 8, 2004, the Examiner: (i) rejected claims 1-3, 8-10 and 15 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,665,422 to Seidel et al. (hereinafter "Seidel"); and (ii) rejected claims 4-7 and 11-14 under 35 U.S.C. §103(a) as being unpatentable over Seidel in view of U.S. Patent No. 6,028,956 to Shustorovich et al. (hereinafter "Shustorovich").

Applicant's attorney appreciates the courtesy and time extended by the Examiner in the teleconferences of April 1, 2004 and April 6, 2004. The following remarks are consistent with the arguments discussed on those dates, which the Examiner indicated would likely overcome the present rejections.

With regard to the rejection of claims 1-3, 8-10 and 15 under 35 U.S.C. §102(e) as being anticipated by Seidel, Applicants assert that such claims are patentable for at least the reasons that claims 1, 8 and 15, from which claims 2, 3, 9 and 10 depend, are patentable.

It is well-established law that "[a] claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." See, e.g., <u>Verdegaal Bros. v. Union Oil Co. of California</u>, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See also, M.P.E.P. §2131. Applicants assert that Seidel fails to teach or suggest each and every element respectively recited in claims 1, 8 and 15 and, thus, the §102(e) rejection of claims 1, 8 and 15 based on Seidel clearly fails to meet the above legal requirements for anticipation. Support for this assertion follows.

Seidel discloses a method and device for recognizing distribution data on postal packets, by combining video coding with the automatic optical character recognition (OCR) evaluation process, including the search for the regions containing the desired information (ROIs).

Independent claims 1, 8 and 15 recite techniques for use in accordance with an automatic mail sorting machine in which a piece of mail is scanned in accordance with an address block locating (ABL) system, and the located address block is analyzed in accordance with an OCR

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system. A coupling is provided between the ABL system and OCR system, capable of feeding results associated with the ABL system as input to the OCR system and results associated with the OCR system as input to the ABL system. Seidel fails to disclose the novel coupling of an ABL system and an OCR system, as recited in independent claims 1, 8 and 15 of the present invention.

In the Office Action, the Examiner states that "if no distribution info is found, it is inherent that the OCR send a message as input to the ROI locator which then further locates ROI's." However, Seidel does not disclose a coupling between a locator system and an OCR system capable of feeding results associated with the OCR system as input to the locator system, as expressly recited in independent claims 1, 8 and 15. Therefore, Seidel does not contain the disclosure which is necessary to support a claim rejection on the basis of inherency.

According to the Federal Circuit, "[i]nherency does not embrace probabilities or possibilities." Trintec Industries, Inc. v. Top-U.S.A. Corp., 295 F.3d 1292, 1297, 63 USPQ2d 1597 (Fed. Cir. 2002). Further, an inherent anticipation requires that the missing descriptive material is necessarily present, and not merely probably or possibly present, in the prior art. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

As evidenced by the arguments presented by the Examiner, there is an absence in Seidel of any teaching of a communication from the OCR to the ROI locator. Furthermore, at column 3, lines 44-59, Seidel states:

> If no distribution information is ascertained and unambiguously recognized in the image 310, the image of the entire surface is superposed with a grid network on the monitor of a video-coding station 320. This grid divides the image into numerous segments. The operator then types in the corresponding segment number to select the segment that contains a large portion of the distribution information . . . In this new recognition attempt, it is also determined whether a region of interest (ROI) is present 350 and if one is, the actual recognition process 370 is performed for the region ROI.

Thus, in Seidel, when no distribution information is found, the operator selects a segment of a grid shown on a monitor that contains the desired information. A new recognition attempt begins based on this operator input, which again starts the ROI locator process. Therefore, Seidel actually teaches away from the present invention in that results of the OCR system are not fed to

the ROI locator as input. Thus, there is no reasonable basis for an assertion that the novel coupling of the ABL system and the OCR system, having the methods of the present invention, <u>necessarily</u> flows from the system disclosed in the Seidel reference, and thus is inherent. No such basis and/or technical reasoning has been provided by the Examiner in the Office Action.

Applicants assert that the dependent claims 2, 3, 9 and 10 contain patentable subject matter in their own right. Accordingly, withdrawal of the §102(e) rejection to claims 1-3, 8-10 and 15 is respectfully requested.

With regard to the rejection of claims 4-7 and 11-14 under 35 U.S.C. §103(a) as being unpatentable over Seidel in view of Shustorovich, Applicants assert that such claims are patentable for at least the reasons that independent claims 1 and 8, from which claims 4-7 and 11-14 depend, are patentable. The patentability of claims 1 and 8 is described above. Shustorovich discloses an object location and span determination in an image, but fails to disclose an ABL system or an OCR system, and thus, also fails to disclose the novel coupling of an ABL system and an OCR system. Accordingly, withdrawal of the rejection to claims 4-7 and 11-14 under 35 U.S.C. §103(a) is therefore respectfully requested.

In view of the above, Applicants believe that claims 1-15 are in condition for allowance, and respectfully request withdrawal of the §102(e) and §103(a) rejections.

Respectfully submitted,

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